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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,782	01/04/2006	Catherine George	0070681-000021	4843

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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07/03/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/537,782	Applicant(s) GEORGE ET AL.	
	Examiner MARC S. ZIMMER	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 9-11 is/are allowed.
- 6) ☒ Claim(s) 1-3, 4-8, 12-15, 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Objections

In response to the Examiner's earlier observation that the variable "R" had been mischaracterized as an "alkyl/aryl" group, Applicant has redefined all of R, R¹, R², R³, R⁴, R^{1'}, R^{2'}, and R^{3'} as alkylene/arylene. However, *only R is an alkylene or arylene*. Applicant should amend the claims in such a fashion that R maintains its present description but the remaining variable are characterized as being alkyl/aryl groups.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-9, 12-15, and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al., U.S. Patent # 5,696,210 in view of Haselhorst et al., U.S. Patent # 6,346,562 for the reasons outlined previously.

It is Applicant's contention that the Examiner's holding of these claims as prima facie obvious is improper insofar as it relies on impermissible hindsight. That is to say, Applicant alleges that *Haselhorst* fails to rationalize why one of ordinary skill would be motivated to replace the phosphite inhibitors mentioned by *King* with phosphite compounds comparable to those being claimed. The Examiner respectfully disagrees. One can easily infer from the description of the state of the art in column 1 of *Haselhorst*, which is directed to a brief overview of the employment of phosphites and phosphines as catalyst inhibitors for addition-curable polysiloxanes, that phosphites

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similar to those mentioned by King are unable to completely inhibit crosslinking at room temperature without negatively impacting the reaction rate at curing temperatures.

Indeed, lines 38-42 indicate that, before the disclosure of that invention, there had been no known inhibitors that would completely preclude reaction at ambient temperature without also slowing the cure under reaction conditions. Insofar as the phosphites inhibitors used prior to those developed by Haselhorst have associated with them this undesirable behavior, it clearly would have obvious to substitute those disclosed by *King* with the ones espoused by *Haselhorst*.

The teachings on which the Examiner's rejection under 35 U.S.C. 103(a) is predicated are offered by the *Haselhorst* disclosure. It was not necessary to rely on Applicant's Specification and, therefore, the rejection is not improper.

As to the idea that a reasonable expectation of success has not been proven, the Examiner is unclear what sort of showing the Applicant believes is necessary. All that is being proposed is the replacement of one catalyst inhibitor with another. *King* teaches every aspect of the claimed invention with the exception of phosphite catalyst inhibitors adhering to formulae (I) and (II) in claim 1. Both *King* and *Haselhorst* intend to use the phosphite compounds disclosed therein as inhibitors to prevent undesirable premature reaction of the components of an addition-curable polysiloxane composition. Why would the skilled artisan not fully expect the invention disclosed in *King* to continue to be operational, and also improved in both storage stability and rate of cure under curing temperatures, if the only modification being made is the exchange of the more

conventional phosphite inhibitors contemplated by *King* with the more sterically encumbered phosphite compounds taught by *Haselhorst*?

Allowable Subject Matter

Claims 4 and 9-11 are allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 26, 2008

/Marc S. Zimmer/
Primary Examiner, Art Unit 1796